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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,258

04/06/2005

Michael John Radley Young

1423-5 PCT US

5378

31554 7590 05/07/2007  
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EXAMINER

ROZANSKI, MICHAEL T

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/509,258

Applicant(s)

YOUNG ET AL.

Examiner

Michael Rozanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/27/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because figure labels and element numbers are handwritten. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 4 is objected to because of the following informalities: The term "guide member" should be changed to "guide means" to be consistent with the "guide means" in claim 1. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 11 recites the limitation "said jaw member" in line 3. There is insufficient antecedent basis for this limitation in the claim, with respect to first or second jaw member. Claims 11 and 14 also used the terms "preferably" and "optionally" which renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Double Patenting***

4. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 1-3, 5-19, and 21 of copending Application No. 10/399,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to the same inventive entity, including a surgical tool with a first and second jaw member that move by a rotational movement, outer shroud means, operating means, multiple guide lobes, an intermediate curved zone shaped to cause jaw means to move at different travel speeds, actuating means, and a trigger mechanism.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by ***Smith et al*** (US 5,873,873).

***Claims 1-19:*** Smith et al disclose an ultrasonic surgical clamp coagulator apparatus for coagulating and/or cutting tissue (col. 1, lines 7-12). The tool includes a 1<sup>st</sup> jaw member 180', a pivotally movable 2<sup>nd</sup> jaw member 191 at a distal end that pivots around a first axis and an axis orthogonal thereto, a longitudinally extending carrier means 170 rotatable about a waveguide 180 that is connected at a proximal end to generate ultrasonic vibrations, outer shroud means 160 including operating means for the 2<sup>nd</sup> jaw member whereby rotation of the carrier means acts on the operating means to cause pivoting of the 2<sup>nd</sup> jaw member into and out of operative relationship with the 1<sup>st</sup> jaw member (see figure 4; col. 10, lines 20-62). Rotation is caused by a rotation knob 216 mounted on the outer tubular sheath (col. 12, lines 49-58). The carrier tube 170 is rotatable within a tubular space defined by an inner wall of the outer shroud tube, which is detachably mounted non-rotatably to a manually operated control means with handset of the tool (col. 12, line 49-col. 13, line 5), and an outer surface of the inner guide member (see figure 4). A pair of lever portions 193 extending proximally are

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positioned on opposite sides of the waveguide 180 and are in operable engagement with a drive portion 194 of the reciprocable actuating member 170 (col. 10, lines 46-62). A proximally facing surface of the 2<sup>nd</sup> jaw comprises a curved zone between two protrusions, wherein rotational movement of a protrusion of one or more guide lobes acts to pivot the 2<sup>nd</sup> jaw into and out of operative relationship with the 1<sup>st</sup> jaw (see figure 10; col. 10, lines 46-62). The 2<sup>nd</sup> jaw is caused to pivot relatively slowly over a coagulation step and relatively rapid over a cutting step and moves between open and closed dispositions by a rotational movement of the carrier means via resilient biasing means (col. 13, lines 6-27).

Furthermore, the 2<sup>nd</sup> jaw follows a three dimensional path when moved, as described with rotational and longitudinal movement above.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Rozanski whose telephone number is 571-272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

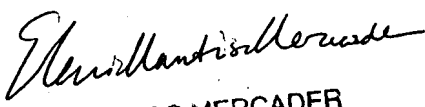
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571-272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR

MR

  
ELENI MANTIS MERCADER  
SUPERVISORY PATENT EXAMINER